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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,274	07/11/2003	Dale Milton Blakely	80012	4839

7590 06/20/2007
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Eastman Chemical Company
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EXAMINER

YOON, TAE H

ART UNIT	PAPER NUMBER
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1714

MAIL DATE	DELIVERY MODE
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06/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/618,274

Applicant(s)

BLAKELY ET AL.

Examiner

Tae H. Yoon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 and 59 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over (elected) claims 18-34 of copending Application No. 10/855,723 (US 2005/0008885 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant UV inhibitor encompasses that of said copending Application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Again, applicant failed to submit terminal disclaimer.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pruett et al (US 4,617,374), Pruett et al (US 5,459,224), Carman et al (US 6,001,952) or Weaver et al (US 6,787,589) in view of Trojan (US 5,898,059), and further in view of Fujimori et al (US 6,703,474).

Pruett et al (abstract, table and example 24), Pruett et al (abstract and claims 1-12), Carman et al (abstract, examples 8 and claims 1-17) or Weaver et al (abstract and claim 10) teach the instant copolyester having reacted UV inhibitor.

The instant invention further recites utilization of a multi-stage pressure reaction, apparatus and various catalysts over Pruett et al, Pruett et al, Carman et al and Weaver et al.

Trojan teaches employing a catalyst system of zinc compound, phosphorus compound and antimony compound in obtaining copolyester articles having a very smooth surface in abstract and examples and cols. 4 and 5. Example 1 shows two reactors, and use of two or more reactors is taught at col. 2, lines 9-27

Also, said utilization of a multi-stage pressure reaction apparatus in obtaining polyesters is well known as taught by Fujimori et al (col. 13, line 16 to col. 14, line 9 and example 1-1; conversion of units meets the instant invention). Said example 1-1 shows the use of magnesium acetate tetrahydrate over the instant manganese compound, but Fujimori et al teach and equate said magnesium (Group IIA metal) and manganese compounds at col. 12, line 45. The molar ratio of a diol and a diacid is taught at col. 13,

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lines 9-12. Fujimori et al also teach employing other metals such as iron or cobalt in order to suppress elution of antimony at col. 8, lines 41-47.

Fujimori et al is cited to show well known utilization of a multi-stage pressure reaction apparatus and metals such as iron or cobalt, not for incorporation of a UV inhibitor already taught by Pruett et al, Pruett et al, Carman et al and Weaver et al. Even though one of the preferred metal catalyst Fujimori et al is a titanium compounds, see *In re Mills*, 477 F2d 649, 176 USPQ 196 (CCPA 1972); Reference must be considered for all that is discloses and must not be limited to preferred embodiments or working examples.


It would have been obvious to one skilled in the art at the time of invention to utilize the catalyst system of zinc compound, phosphorus compound and antimony compound of Trojan in Pruett et al, Pruett et al, Carman et al and Weaver et al, and further to utilize the multi-stage pressure reaction apparatus and catalyst system of manganese compound, phosphorus compound and antimony compound with iron or cobalt taught by Fujimori et al (such as example 1-1 with varying pressures taught at col. 13, line 60 to col. 14, line 9) in making the UV inhibitor reacted polyesters of Pruett et al, Pruett et al, Carman et al and Weaver et al, thereof, since it is well known in the art that said multi-stage pressure reaction method would provide a better control on molecular weights and yield as taught by Fujimori et al and since a catalyst system of zinc compound, phosphorus compound and antimony compound yielding articles having a very smooth surface is well known as taught by Trojan.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Tae H Yoon
Primary Examiner
Art Unit 1714

THY/June 18, 2007